

REMARKS

A. 35 U.S.C. § 102(b)

In the Office Action mailed on February 3, 2003, claims 1-4, 14 and 19-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by Chapman et al. Applicant traverses this rejection. Independent claims 1 and 19 each recites an analyzer that suppresses the intensity of a portion of a beam that is transmitted through an object. Chapman et al. does not disclose an analyzer that suppresses a portion of a beam transmitted through an object. Accordingly, claims 1 and 19 and their dependent claims 2-4, 14 and 20-22 are not anticipated by Chapman et al. and so the rejection is improper and should be withdrawn.

It is noted that the Office Action asserted that Chapman et al. disclosed an analyzer that suppressed a portion of a beam transmitted through an object. Applicant disagrees with this assertion. Evidence that the assertion is improper is that the Office Action fails to explicitly point out where Chapman et al. discloses such suppression. If this assertion is repeated, Applicant requests that the next Office Action explicitly point out where Chapman et al. discloses such suppression. If the next Office Action fails to identify where Chapman et al. discloses such suppression, then it should be deemed an admission that Chapman et al. does not disclose such suppression.

Besides not being anticipated by Chapman et al., the claims are not rendered obvious by Chapman et al. As disclosed in Chapman et al., an absorption image I_A is determined (Col. 9, l.

65 – Col. 10, l. 10) and used to derive four beam images (Col. 10, ll. 11-55). Obviously, suppression of the absorption image I_A would degrade the results for the four beam images mentioned previously. Since there is no motivation to degrade the four beam images, there is no motivation in Chapman et al. to use an analyzer that suppresses the intensity of a portion of a beam that is transmitted through an object. Thus, the claims are patentable over Chapman et al.

B. 35 U.S.C. § 103

1. Chapman et al. and Momose

Claim 5 was rejected under 35 U.S.C. § 103 as being obvious in view of Chapman et al. and Momose. Applicants traverse this rejection. As pointed out above in Section A, Chapman et al. does not disclose an analyzer that suppresses a portion of a beam transmitted through an object as recited in independent claim 1. Momose also does not suggest using an analyzer in Chapman et al. that suppresses a portion of a beam transmitted through an object. Without such suggestion, the rejection is improper and should be withdrawn.

2. Chapman et al.

Claims 6-9, 15-17 and 23-25 were rejected under 35 U.S.C. § 103 as being obvious in view of Chapman et al. Applicants traverse this rejection. As pointed out above in Section A, Chapman et al. does not suggest using an analyzer that suppresses a portion of a beam transmitted through an object as recited in independent claims 1 and 19. Without such suggestion, the rejection is improper and should be withdrawn.

3. **Chapman et al. and Seely et al.**

Claims 10-13 were rejected under 35 U.S.C. § 103 as being obvious in view of Chapman et al. and Seely et al. Applicants traverse this rejection. As pointed out above in Section A, Chapman et al. does not disclose an analyzer that suppresses a portion of a beam transmitted through an object as recited in independent claim 1. Seely et al. also does not suggest using an analyzer in Chapman et al. that suppresses a portion of a beam transmitted through an object. Without such suggestion, the rejection is improper and should be withdrawn.

C. **35 U.S.C. § 102(f)**

Claims 1-7 were rejected under 35 U.S.C. § 102(f) because the Applicant did not invent the claimed subject matter. The rejection is based on the existence of commonly owned U.S. Patent Application Serial No. 09/797,498 (“the ‘498 application”). Applicant traverses this rejection. In particular, Applicant signed a Declaration in the present application that stated that the Applicant was the sole inventor of the invention claimed. Accordingly, there is a presumption that the Applicant is the inventor of the invention claimed. MPEP § 2137.01. In addition, a Declaration signed by the inventors of the ‘498 application is being submitted concurrently with the present Response that states that the inventors of the ‘498 application are not the inventors of the claims of the present application. Accordingly, the rejection is improper and should be withdrawn.

D. 35 U.S.C. § 102(g)

Claims 1-7 were rejected under 35 U.S.C. § 102(g) because they were directed to the same invention as that of claims 1-4, 7-9 and 19-22 of the '498 application. Applicant traverses this rejection. In particular, Osmic, Inc., the assignee of the present application and the '498 application, states that the inventions of claims 1-7 of the present application were invented by Mr. Protopopov prior to the date of invention of claims 1-4, 7-9 and 19-22 of the '498 application. Accordingly, the rejection should be withdrawn.

E. Obviousness-Type Double Patenting

Claims 1-7 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being obvious in view of claims 1-4, 7-9 and 19-22 of the '498 application. Applicant traverses this rejection to the extent that it is premature at this stage since the claims of the present application and the claims of the '498 application may be changed in the future rendering the rejection moot. When claims 1-7 of the present application are deemed allowable and the only issue remaining is obviousness-type double patenting with regards to the '498 application, then Applicant will fully address this issue.

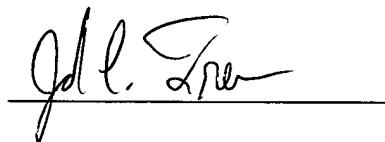
F. Claim 18

Applicant notes with appreciation that claim 18 has been indicated to contain allowable subject matter. Note that Applicant traverses the reasons of allowability regarding claims 18 in that that there are broader and/or other reasons why the claim is allowable.

CONCLUSION

In view of the arguments above, Applicant respectfully submit that all of the pending claims 1-25 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, she is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,



John C. Freeman
Registration No. 34,483
Attorney for Applicant

BRINKS HOFER
GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610
(312) 321-4200

Dated: May 5, 2003